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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,169	07/13/2005	Edward A. Boyd	21242P	8248
210	7590	03/25/2008	EXAMINER	
MERCK AND CO., INC			SHAMEEM, GOLAM M	
P O BOX 2000				
RAHWAY, NJ 07065-0907			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			03/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/542,169	BOYD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Golam M. M. Shameem, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 AND 25-29 is/are pending in the application.

4a) Of the above claim(s) 26-29 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 AND 25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

Receipt is acknowledged of amendment / response filed on January 25, 2008 and that has been entered.

Claims 1-10, and 25-29 are currently pending in the application. Claims 11-24 have been canceled. Claims 25-29 have been added.

Claims 26-29 are withdrawn (as being dependent upon a canceled base claim 11) from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

### ***Response to Arguments***

Applicant's amendments and arguments [to withdrawal of the rejection of claims 1-10] have been fully considered and found persuasive with respect to the above rejection and the rejection is hereby withdrawn. However, upon further consideration, the following new ground of rejection is made and therefore, Applicants arguments are rendered moot in view of the present Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain the subject matter of a newly introduced proviso compound of formula I such as,

provided that the compound of formula I is not 1H-Indole-3-acetamide, 1-(4-chlorobenzoyl)-5-methoxy-2-methyl-N-[5-(1-methylethyl)-2-thiazolyl] 1H-Indole-3-acetic acid, 1-(4-chlorobenzoyl)-5-methoxy-2-methyl-3-pyridinyl ester; or 1H-Indole-3-acetamide, 1-(4-chlorobenzoyl)-5-methoxy-2-methyl-N-3-pyridinyl.

[claim

1 (Currently Amended), page 4, last 4 lines] to exclude the prior art compounds. These subject matters are considered as **new matters** since the specification and the originally filed claims excluded these subject matters from the compounds as can be seen by original claims 1-24 and in the specification on pages 3-14. The amendment changes the scope of the claims to exclude the compound of formula I with the newly introduced proviso compounds that were not previously included in the invention. This rejection can be overcome by deleting the new matter from the instant claims and also amend the claims within the context and scope of the claims (limiting with specific type of compounds that actually contemplated in the specification) in order to overcome the rejection.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golem Shamed, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

/Golam M. M. Shameem, Ph.D./  
Primary Examiner  
Art Unit 1626  
Technology Center 1600

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